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EXAMINER				
RAJ, RAJIV J				
ART UNIT		PAPER NUMBER		
3686				
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12/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/649,237

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

RAJIV J. RAJ

**Art Unit**

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the application filed on 04 September 2008.
2. Claims 1-3, 5-15, 18 & 20 have been amended.
3. Claims 1-20 are currently pending and have been examined.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The limitations of claim 9 are data structures that are not claimed as embodied in computer-readable media, and therefore are not statutory because they are not capable of causing functional changes in the computer. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Dependent claims 10-14 fail to cure this deficiency of claim 9, and thus are rejected on the same grounds. (MPEP § 2106.01)
6. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 has in its preamble "A *computer-readable*

*medium having a data structure thereon for managing deductibles for insurance policies, said data structure".* Claim 9, as currently written, does not have the functional descriptive material (a program) as structurally and functionally interrelated to the medium. Instead, claim 9 should be directed to an **executable** computer program that is **tangibly embodied** on a computer readable medium. In addition, the amendments to claim 9's with respect to this rejection, are made in the preamble, and therefore do not cure the stated issue with claim 9. Furthermore, it is unclear to the Examiner if the use of the term "*data structure*", in claim 9, conforms to IEEE standard required by the MPEP. (MPEP § 2106.01)

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-5, and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker (US 5832447) (hereinafter Rieker) in view of Bosco et al. (US 5191522) (hereinafter Bosco).
10. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claim 1****Rieker as shown, discloses the following limitations:**

- *providing a plurality of interrelated tables;* (see at least Rieker Fig:9 A-D & related text)
- *providing a first key reference in one table, the first key reference identifying a first specific group of the variables;* (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)
- *matching the first key reference to another table,* (see at least Rieker Fig:7B Item:266 & related text)

- *the first key reference identifying a second specific group of variables and a plurality of additional key references; and (see at least Rieker Fig:9B Item:400-466 & related text)*
- *wherein the determining comprises comparing a first deductible with a second deductible; (see at least Rieker Fig:7B Items:264,268 Fig:7C Item:286 & related text)*

Rieker does not disclose the following limitations, however Bosco, as shown does:

- *providing a plurality of policy variables for each table; (see at least Bosco Column:8 Lines:42-51)*
- *matching the plurality of additional key references to a plurality of respective additional tables, the additional key references identifying a plurality of additional specific groups of variables; (see at least Bosco Column:9 Lines:10-18 Lines:20-25)*
- *to determine a deductible for a related policy renewal; (see at least Bosco Column:9 Lines:10-18)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker. One of ordinary skill in the art would have added these features into Rieker with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

## **Claim 2**

The combination of Rieker/Bosco disclose all of the limitations of claim 1. Rieker further discloses the following limitation:

- *in the first table, providing a geographical variable, a transaction variable and an effective policy date variable* (see at least Rieker Fig:10 A-B & related text)

### **Claim 3**

The combination of Rieker/Bosco disclose all of the limitations of claim 2. Bosco further discloses the following limitation:

- *in the second table, providing a first deductible variable and a second deductible variable* (see at least Bosco Column:7 Lines:58-62, column:9 Lines:43-45, Fig:10 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

### **Claim 4**

The combination of Rieker/Bosco disclose all of the limitations of claim 3. Bosco further discloses the following limitation:

- *in one of the additional tables, providing variables distinguishing deductibles available to the policies* (see at least Bosco Column:11 Lines:42-59)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

**Claim 5**

The combination of Rieker/Bosco disclose all of the limitations of claim 3. Bosco further discloses the following limitation:

- *in another of the additional tables, providing variables identifying change from the first deductible to the second deductible;* (see at least Bosco Column:7 Lines:58-62)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

**Claim 7**

The combination of Rieker/Bosco disclose all of the limitations of claim 1. Bosco further discloses the following limitation:



- *another table controls each variable used to distinguish a first deductible variable from a second deductible variable (see at least Bosco Column:7 Lines:58-62& Column:9 Lines:43-45)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

#### **Claim 8**

The combination of Rieker/Bosco disclose all of the limitations of claim 7. Rieker further discloses the following limitation:

- *the additional tables respectively provide variables distinguishing deductibles available to the policies and identifying change from the first deductible to the second deductible (see at least Rieker Fig:7G Items:366-370 & related text)*

#### **Claim 9**

**Rieker as shown, discloses the following limitations:**

- *a plurality of interrelated tables; (see at least Rieker Fig:9 A-D & related text)*
- *the variables in a first table including a geographical variable, a transaction variable and an effective policy date variable; (see at least Rieker Fig:10 A-B & related text)*

- *the variables in an additional table;* (see at least Rieker Fig:7G Item:366-370 & related text)

Rieker does not disclose the following limitations, however Bosco, as shown does:

- *a plurality of policy variables in each table;* (see at least Bosco Column:8 Lines:42-51)
- *the variables in a second table including first deductible variables and second deductible variables;* (see at least Bosco Column:7 Lines:58-62, Fig:10 & related text)
- *the variables in a further table distinguishing deductibles available to the policies;* (see at least Bosco Column:11 Lines:42-59)
- *determining a deductible for a related policy;* (see at least Bosco Column:8 Lines:8-28)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker. One of ordinary skill in the art would have added these features into Rieker with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

#### **Claim 10**

The combination of Rieker/Bosco disclose all of the limitations of claim 9. Rieker further discloses the following limitation:

- *the first table includes a first key reference* (see at least Rieker Fig:9A Items:500-502 & related text)

**Claim 11**

The combination of Rieker/Bosco disclose all of the limitations of claim 10. Rieker further discloses the following limitation:

- *the first key reference identifies a first specific group of variables (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)*

**Claim 12**

The combination of Rieker/Bosco disclose all of the limitations of claim 11. Rieker further discloses the following limitation:

- *the first key reference is matched to the second table (see at least Rieker Fig:7B Items:266 & related text)*

**Claim 13**

The combination of Rieker/Bosco disclose all of the limitations of claim 12. Rieker further discloses the following limitation:

- *the first key reference identifies a second specific group of variables and a plurality of additional key references (see at least Rieker Fig:9B Items:400-466 & related text)*

**Claim 14**

The combination of Rieker/Bosco disclose all of the limitations of claim 13. Bosco further discloses the following limitation:

- *the plurality of additional key references are matched to a plurality of respective additional tables; (see at least Bosco Column:9 Lines:10-18)*

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

**Claim 15**

**Rieker as shown, discloses the following limitations:**

- *a storage device storing a program;* (see at least Rieker Fig:3 Items:100, 150B, Fig:4 Items:172 & related text)
- *a processor coupled to the storage device* (see at least Rieker Fig:3 Items:100, 150B, Fig:4 Items:172 & related text)
- *operative with the program for processing data in a plurality of interrelated tables;* (see at least Rieker Fig:300 Items:100,110 Fig:9 A-D & related text)
- *the variables in a first table including a geographical variable, a transaction variable and an effective policy date variable;* (see at least Rieker Fig:10 A-B & related text)
- *the variables in an additional table determining change from first deductible to a second deductible for a related policy;* (see at least Rieker Fig:7G Item:366-370 & related text)

Rieker does not disclose the following limitations, however Bosco, as shown does:

- *a plurality of policy variables in each table;* (see at least Bosco Column:8 Lines:42-51)
- *the variables in a second table including first deductible variables and second deductible variables;* (see at least Bosco Column:7 Lines:58-62, Fig:10 & related text)
- *the variables in a further table distinguishing deductibles available to the policies;* (see at least Bosco Column:11 Lines:42-59)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker. One of ordinary skill in the art would have added these features into Rieker with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

#### **Claim 16**

The combination of Rieker/Bosco disclose all of the limitations of claim 15. Rieker further discloses the following limitation:

- *the first table includes a first key reference* (see at least Rieker Fig:9A Items:500-502 & related text)

#### **Claim 17**

The combination of Rieker/Bosco disclose all of the limitations of claim 16. Rieker further discloses the following limitation:

- *the first key reference identifies a first specific group of variables* (see at least Rieker Fig:9 B-D Items:400, 600, 700 & related text)

### **Claim 18**

The combination of Rieker/Bosco disclose all of the limitations of claim 17. Rieker further discloses the following limitation:

- *the first key reference is matched to the second table* (see at least Rieker Fig:7B Items:266 & related text)

### **Claim 19**

The combination of Rieker/Bosco disclose all of the limitations of claim 18. Rieker further discloses the following limitation:

- *the first key reference identifies a second specific group of variables and a plurality of additional key references* (see at least Rieker Fig:9B Items:400-466 & related text)

### **Claim 20**

The combination of Rieker/Bosco disclose all of the limitations of claim 19. Bosco further discloses the following limitation:

- *the plurality of additional key references are matched to a plurality of respective additional tables;* (see at least Bosco Column:9 Lines:10-18)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

11. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rieker in view of Bosco in further view of Garrett et al. (US 5325291) (hereinafter Garrett).

**Claim 6**

The combination of Rieker/Bosco disclose all of the limitations of claim 1. Garrett further discloses the following limitation:

- *the first table controls an initial placement of the first key reference on the second table;* (see at least Garrett Fig:5,6 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Bosco into Rieker/Bosco. One of ordinary skill in the art would have added these features into Rieker/Bosco with the motivation of providing a more efficient and effective method for managing insurance related costs. (see at least Bosco Column:3 Lines:25-45)

***Response to Arguments***

12. Applicant's arguments received on 04 September 2008 have been fully considered but they are not persuasive. Applicants' arguments will be addressed herein below in the order in which they appear in the response filed 04 September 2008.

13. As per claim 1, Applicant argues prior art in the first Office Action does not teach or suggest added and amended claim language. Examiner respectfully disagrees and

points out that this claim language was not addressed in the first Office Action because this claim language is not included in the previous application. Applicant's argument is moot in light of the cited prior-art.

14. As per claim 1 applicant argues the patentability of claim 1, based on issues with prior art reference Rieker. Examiner respectfully disagrees with Applicant's arguments and points out that prior art references must be considered in the entirety and taken in combination with other cited prior-art.
15. As per claims 2-8 applicant makes the same general arguments found in claim 1, and are rejected for on the same grounds

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJIV J. RAJ whose telephone number is (571) 270-3930. The examiner can normally be reached on Monday thru Friday 8-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative

or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/RJR/, Art Unit 3686

12/04/08

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